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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/368,828 08/05/99 MASHINSKY

A 9118-037

020583  
PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

WM01/0918

EXAMINER

TIEU, R

ART UNIT

PAPER NUMBER

2643

DATE MAILED:

09/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/368,828

Applicant(s)  
MASHINSKY et al.

Examiner  
Binh K. Tieu

Art Unit  
2643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Jul 31, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-27 and 38-73 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 1-27 and 38-64 is/are allowed.

6) ☒ Claim(s) 65-73 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Allowable Subject Matter*

1. This Application has been carefully reviewed. As the results, the indicated allowability of claims 65-73 is withdrawn in view of the rejections based on the previous cited reference, Walker et al. (U.S. Pat.#: 5,794,207).

2. Claims 1-27 and 38-64 are allowed.

3. The following is a statement of reasons for the indication of allowable subject matter:

Walker et al. (U.S. Pat.#: 5,794,207) whose Assignee is Walker Asset Management Limited, is known as "Priceline.com" teaches a service/good sale system comprising a plurality of sellers and buyers, a central controller linking buyers and sellers interfaces for exchanging purchase orders, and databases storing all data related to good/service sale system transactions. However, Walker sale system, in combination with other cited prior art of record, failed to teach the features of:

a/. Brokering a transaction that effects a transfer of ownership of the offered telecommunication service from the seller to the buyer as substantially described and connected in independent claims 1 and 38; and

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b/. Defining classes for telecommunications service and grading of telecommunication service, as substantially described and connected in independent claims 12 and 49;

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>®</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 65-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Pat.#: 5,794,207).

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Regarding claim 65, Walker teaches a goods and/or service sale system as shown in figure 1, comprising:

- a plurality of sellers (i.e., seller interfaces 300);

- a plurality of buyers (i.e., buyer interfaces 400);

- a secure network site connected to a server node (i.e., central controller 200) for receiving sell and purchase orders from the sellers and buyers, respectively, for goods and/or services (i.e., conditional purchase offer (CPO) are inputted by buyers and sells are inputted by sellers, col.17, line 48 - col.29; also note that seller database contains sellers' information such as type of services provided by sellers, such information are provided by the sellers when they registered, col.13, lines 10-22);

- for each sell order, means for verifying the seller's goods or service parameters (col.19, lines 29-45);

- a database for storing sell and purchase orders (i.e., purchase confirmation database 270 storing sellers' responses, col.19, lines 49-54; database 265 for storing CPOs of buyers, col.17, lines 48-56; or other confirmation databases, col.13, lines 40-49); and

- means for identifying a seller's service or goods that automatically satisfied a buyer's service purchase order (i.e., central controller 200 receives a seller response among the plurality of sellers. It should be understood that the central controller 20 identifies a seller providing seller response, based on extracted seller's ID, and automatically binding the seller response to one of

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the plurality of received CPOs that satisfies a buyer's service purchase order, col.19, lines 30-45).

It should be noticed that Walker teaches the method of trading goods and/or services including Airline tickets, Hotel services, Car Insurance services, etc. as stated above. Walker fails to teach such method of trading in a telecommunications environment. However, it should be noticed that Walker teaches bids and their negotiations are transmitted via any type of communications means such as fax, telephone, Internet, E-mail, etc. It is well-known by those skilled in the art to realize that competitive telecommunications services are provided by different telecommunications service providers with different offering rates that allowed caller to select the best service provider to route his or her call. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of method of trading goods and services into telecommunication services environment, into view of Walker, in order to provide benefit of telecommunication service users on offered telecommunication services.

Regarding claim 66, Walker further teaches the limitations of the claim in the figure 1, central controller 200.

Regarding claims 67 and 68, Walker further teaches the limitations of the claims in col.23, lines 20-25.

Regarding claims 69 and 70, Walker further teaches the limitations of the claims in col.19, lines 29-37 that the seller is an airline which is not a telecommunications carrier .

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Regarding claim 71, Walker further teaches that when the CPO is received from the user as requested, if the available credit on the buyer's credit card is sufficient, the CPO is approved and a unique tracking number is added to the CPO, col.17, lines 27-51; col.28, lines 5-8. Otherwise, the CPO is rejected and returned to the buyer.

Regarding claims 72-73, Walker further teaches the limitations of the claims in col.16, lines 46-51.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Binh K. Tieu** whose telephone number is **(703) 305-3963**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Curtis Kuntz**, can be reached on **(703) 305-4708** and Customer Service **(703) 306-0377**.

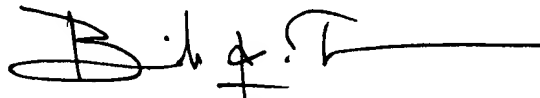
**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist, tel. No. 703-305-4700).



**BINH TIEU**  
**PRIMARY EXAMINER**  
**Art Unit 2643**

**Date: September 14, 2001**